REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-26 are pending in the application. Claims 1-26 are rejected. No new matter has been added as result of amendments.

REJECTIONS

35 U.S.C. §101 – Claims 1-9 and Claims 22-26

Claims 1-9 and Claims 22-26 are rejected under 35 U.S.C. §101, as directed to non-statutory subject matter. Specifically, Claims 1-9 and 22-26 are rejected because the claimed data structure is disposed in a computer readable memory, which is not statutory.

The present Office Action states: "A data structure is statutory when it is functional. For example if the data structure were to increase efficiency, then that data structure would be statutory" (pg. 2, lines 17-18, of the Office Action dated February 27, 2008). The Office Action further states: "Data structures are statutory when they are stored within a memory. The current claim language claims that a data structure is disposed in a computer readable memory, not stored. Plus, applicant's disclosure fails to describe the computer readable memory and database as being of statutory types" (pg. 3, lines 7-10) (emphasis in original).

Applicants respectfully disagree based at least on the following rationale.

MPEP §2106.01 states in part (emphasis added):

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) ...
> ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). ...
>
> USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983).

Applicants respectfully submit that the rejection of the claims is improper as the Claims 1-9 and 22-26 satisfy the requirements of 35 U.S.C. §101 as laid out in MPEP §2106.01 cited above.

Independent Claim 1 recites (emphasis added):

> 1. A data structure disposed in a computer readable memory for providing information corresponding to a geographic location, said data structure comprising:
> a first data field for identifying said location; and

a second data field associated with said first data field for containing said information, wherein a user can access said information.

Claim 22 has similar embodiments. Moreover, Claims 2-9 that depend from independent Claim 1 and Claims 23-26 that depend from independent Claim 22 also include these embodiments.

Applicants respectfully submit that a "data structure disposed in a computer readable memory for providing information" and "wherein a user can access said information" meets the definition of a data structure laid out in MPEP §2106.01, a "data structure" being "a physical or logical relationship among data elements, designed to support specific data manipulation functions." Here, as recited in Claim 1, the "data structure" is "disposed in a computer readable memory" to "provide information" such that "a user can access said information." Applicants respectfully submit that "providing information" so that "a user can access said information" are such "specific data manipulation functions." Moreover, Applicants respectfully submit that the "data structure" as claimed is "a physical or logical relationship among data elements, designed to support" these functions, because the data structure comprises "a first data field …" and "a second data field associated with said first data field … ," the logical relationship between these two data fields being their mutual association. Therefore, Applicants respectfully submit that Applicants' "data structure" is statutory because it is functional in that the claimed "data structure" provides "associated" information so that it is accessible to a user.

The Office Action further states: "Data structures are statutory when they are stored within a memory. The current claim language claims that a data structure is disposed in a computer readable memory, not stored" (pg. 3, lines 7-9) (emphasis in original). Applicants note MPEP §2106.01 which states that: ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") Applicants assert that the Office Action's grounds for rejection is "based solely on words appearing in the claims" and that the "the claimed invention, as a whole, must be evaluated for what it is." Here, the Office Action objects to the use of the term "disposed" in deference to the term "stored." Applicants respectfully submit that the written description, if not Claim 1 itself, makes clear that "disposed" provides the functionality of "stored," otherwise it would not be possible that "a user can access said information," as claimed. Applicants respectfully assert that the "invention must be evaluated as claimed," and that "USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art," per MPEP §2106.01. (Emphasis added.)

Finally, the Office Action states: "... applicant's disclosure fails to describe the computer readable memory and database as being of statutory types" (pg. 3, lines 9-10). Applicants respectfully assert that at least FIG. 11 and the discussion

thereof on pages 52-54 of Applicants' patent application provide adequate description of the Applicants' embodiments of the present invention as a "statutory type." Moreover, Applicants note that the discussion of Applicants' "data structure" in Claim 1 provided above supports Applicants' embodiments of the present invention as being a "statutory type."

Therefore, Applicants respectfully assert that independent Claims 1 and 22 recite to statutory subject matter under 35 U.S.C. §101, and as such are in condition for allowance. As Claims 2-9 depend from Claim 1 and Claims 23-26 depend from Claim 22, Applicants respectfully submit that Claims 1-9 and Claims 22-26 overcome the above rejection.

REJECTIONS

35 U.S.C. §102(e) – Claims 1-26

The Office Action dated February 27, 2008, states that Claims 1-26 are rejected under 35 U.S.C. §102(e) as being anticipated by Tahtinen, et al. (US Publication 20010046228), hereinafter referred to as Tahtinen. Applicants have reviewed Tahtinen and respectfully submit that the embodiments as recited in Claims 1-26 are not anticipated by Tahtinen in view of at least the following rationale.

MPEP §2131 provides:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

> single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicants respectfully submit that the rejection of the claims is improper as the rejection of Claims 1-26 does not satisfy the requirements of a *prima facie* case of anticipation as claim embodiments are not met by Tahtinen. Applicants respectfully submit that Tahtinen does not teach or suggest the claimed embodiments in the manner set forth in independent Claims 1, 10, 16 and 22.

Independent Claim 1 is recited above. Independent Claims 10, 16 and 22 recite similar embodiments to Claim 1. Moreover, Claims 2-9 that depend from independent Claim 1, Claims 11-15 that depend from independent Claim 10, Claims 17-21 that depend from independent Claim 16 and Claims 23-26 that depend from independent Claim 22 also include these embodiments. Applicants respectfully submit that Tahtinen does not teach, describe or suggest "A <u>data structure</u> disposed in a computer readable memory <u>for providing information corresponding to a geographic location</u> ... comprising: <u>a first data field for identifying said location</u>; ..." as claimed (emphasis added).

The Office Action dated February 27, 2008, states in part (paragraph 1, pg. 4): " ... Tahtinen teaches a data structure disposed in a computer readable memory for providing information corresponding to a geographic location, said

data structure comprising: a first data field for identifying said location (equivalent to coordinate information, paragraph 4, Tahtinen); and a second data field associated with said first data field for containing said information, wherein a user can access said information (equivalent to subscriber number, paragraph 4, Tahtinen)." Similar bases for rejection are found at paragraph 10, pg. 6 with respect to Claim 10, at paragraph 11, pg. 7 with respect to Claim 16, and at paragraph 12, pp. 7 and 8 with respect to Claim 22 of the Office Action dated February 27, 2008.

The Office Action asserts that Tahtinen teaches the embodiment, "geographical location," in the claim language of Claim 1 as found in Tahtinen at paragraph [0004]:

> [0004] The present invention is based on implementing the selection of a telephone network subscriber by means of an addressable point in the coordinate space of a given virtual-reality world, which in practice means that there exists a data structure in which the subscriber number information is associated with a certain point of the coordinate space of the virtual-reality world. ..." (Emphasis added.)

Applicants do not understand Tahtinen to teach a "geographical location" as "an addressable point in the coordinate space of a given virtual-reality world."

Rather, referring to Tahtinen's title, and abstract, amongst other places, Applicants understand Tahtinen to teach (Abstract of Tahtinen):

> "The present invention relates to a method and arrangement for interconnecting a virtual-reality world (3) and the real world (7) for the purpose of establishing a real-time communications connection such as a telephone call connection. According to the method, a

> three-dimensional virtual-reality world (3) is formed. According to the invention, a subscriber of the real-world telephone network (7) is selected on the basis of a point in the coordinate space of the virtual-reality world (3), and the connection is established from the user (1) to the real-world telephone network subscriber (7) over the same communications channel as is used for establishing the connection toward the virtual-reality world (3). " (Emphasis added.)

Tahtinen does not mention a "geographical location" and therefore Applicants do not understand Tahtinen to teach a "data structure … for providing information corresponding to a geographic location, … comprising: a first data field for identifying said location," as recited by Applicants' Claim 1 (emphasis added). Instead, Applicants understand Tahtinen to teach, as cited above in Abstract of Tahtinen, "a method and arrangement for interconnecting a virtual-reality world (3) and the real world (7)" wherein "a subscriber of the real-world telephone network (7) is selected on the basis of a point in the coordinate space of the virtual-reality world (3), and the connection is established from the user (1) to the real-world telephone network subscriber (7) …" Applicants' note that Tahtinen teaches "a point in the coordinate space of the virtual-reality world (3)" and does not teach that the "point in the coordinate space" is in the "real world." Rather, Tahtinen teaches in the Abstract of Tahtinen that the "real world" is separate and distinct from the "virtual-reality world," for example, when Tahtinen in the Abstract states "a method and arrangement for interconnecting a virtual-reality world (3) and the real world (7)," see also FIG. 1 and the discussion thereof in paragraphs [0010] through [0012] of Tahtinen.

Moreover, in paragraph [0012], Tahtinen teaches (emphasis added):

> "[0012] By navigating to a desired point in the virtual-reality world 3, the user 1 can address, via coordinate points x,y,z of the three-dimensional virtual-reality world 3, the subscribers 7 of the real-world telephone network 9 associated with said coordinate points, thus establishing a voice connection to said subscribers if so desired. ..."

The Office Action states on pg 9 lines 17-18 that "... coordinates are geographic locations." If Tahtinen's "point in the coordinate space" were in the "real world" as the Office Action seems to suggest by equating Tahtinen's "point in the coordinate space" to Applicants "geographical location," Applicants fail to understand why Tahtinen would specifically state that the location of the "point in the coordinate space" is in "the virtual-reality world." Moreover, Applicants fail to understand the Office Action's seeming contention that a "geographical location" of an entity in the real world, for example, given in latitude and longitude on the surface of the Earth, could possibly be located in a "virtual-reality world," such as Tahtinen's "virtual-reality world."

Applicants respectfully submit that Tahtinen does not disclose nor teach "A data structure disposed in a computer readable memory for providing information corresponding to a geographic location, said data structure comprising: a first data field for identifying said location; and a second data field associated with said first data field for containing said information, wherein a user can access said information," as claimed (emphasis added). Therefore, Applicants submit that Tahtinen fails to disclose each and every element of Claim

1, arranged as required by the Claim. As similar embodiments are found in independent Claims 10, 16 and 22, Applicants respectfully assert that Tahtinen does not teach, disclose or suggest the claimed embodiments as recited in independent Claims 10, 16 and 22. As the claimed embodiments are not met by Tahtinen, Applicants respectfully submit that the rejection does not satisfy the requirements of a *prima facie* case of anticipation. Therefore, Applicants respectfully submit that Claims 10, 16 and 22 overcome the rejection under 35 U.S.C. § 102(e), and that these claims are thus in a condition for allowance.

Claims 2-9 depend from independent Claim 1; Claims 11-15 depend from independent Claim 10; Claims 17-21 depend from independent Claim 16; and Claims 23-26 depend from independent Claim 22. Therefore, Applicants respectfully submit that Claims 2-9, Claims 11-15, Claims 17-21 and Claims 23-26 also overcome the rejection under 35 U.S.C. § 102(e), and are in a condition for allowance as being dependent on allowable base claims.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER L.L.P.

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/John P. Wagner, Jr./
John P. Wagner, Jr.
Registration No. 35,398

123 Westridge Dr.
Watsonville, CA 95076
(408) 377-0500